

**REMARKS**

Claims 2, 3, 5, 15, 17-18, 25-26, 29-30, 33-34, 37 and 39-40 remain pending in the application.

**Claim Amendments**

Claim 2 is amended to clarify that the hydrophobic polymer phase is comprised of a hydrophobic polymer. Support for this amendment resides at page 14, lines 19-23 of the specification. No new matter is added by this amendment.

**Allowable Subject Matter**

Applicants acknowledge with thanks the indication of allowable subject matter of claims 5, 17, 26, 34 and 40. In view of the following remarks, and the attached Declaration under 37 CFR 1.132, it is believed that all other pending claims are also allowable.

**Interview with Examiner**

Applicants thank the Examiner for the courtesy extended toward applicants' representative during the interview of October 3, 2005. During the interview, the above amendment of claim 2 was discussed. As a result of the amendment of claim 2, the Examiner agreed that the rejection over the Leon and Van Damme references would be withdrawn.

The Declaration under 37 CFR 1.132 submitted herewith was also discussed in relation to the rejection over the Verschueren et al reference. The Examiner indicated that she would need to review the substance of the Declaration in more detail prior to determining whether the submission of the Declaration overcomes the rejection over Verschueren.

During the interview, the Examiner also raised a question concerning the meaning of the "locally foamed" (claims 3 and 15) and "locally heat melted" (claims 25, 26 and 37) limitations of the claims. In response, applicants direct the Examiner's attention to the specification at the sentence bridging pages 30-31, as well as at pages 33-35 for a discussion of these embodiments.

#### **Withdrawn Objection**

Applicants acknowledge the Examiner's withdrawal of the objection to the claims as being substantial duplicates in view of the prior amendment.

#### **Rejection under 35 USC 112 (paragraph two)**

Claims 2-3, 15, 18, 25, 29, 30, 33, 37 and 39 stand rejected under 35 USC 112 (paragraph two) as not distinctly claiming the invention. This rejection respectfully is traversed.

In support of the rejection, the Examiner takes the position that the claims do not recite the presence of a hydrophobic polymer in the photosensitive layer consistent with the teachings of the specification.

In response, claim 2 is amended to clarify that a hydrophobic polymer is present in the hydrophobic polymer phase. The rejection of claim 2 (and the corresponding dependent claims 15, 18, 25, 29 and 30) is thus overcome.

With regard to the rejection of claims 3, 33, 37 and 39, the rejection is without basis as claims 3 and 37 (contrary to the Examiner's position) clearly provide for the presence of a hydrophobic polymer. The Examiner during the interview acknowledged that claims 3, 33, 37 and 39 should not have been rejected for this reason, and that the rejection of these claims would be withdrawn.

The rejection is thus without basis and should be withdrawn.

**Rejection under 35 USC 102(e) over Verschueren et al**

Claims 2-3, 15, 18, 25, 29-30, 33, 37 and 39 stand rejected under 35 USC 102(e) as being anticipated by Verschueren et al.

This rejection respectfully is traversed.

Verschueren et al is directed to a heat-sensitive material for making lithographic printing plates having on a lithographic

support an image-forming layer including a hydrophilic binder, a crosslinking agent for the hydrophilic binder, metal oxide particles with a mean diameter of at least 100 nm, and dispersed hydrophobic thermoplastic polymer particles.

The reference teaches that particles of titanium dioxide or other metal oxide are incorporated in the heat-sensitive layer. Such particles are present in an amount of from 50 to 95% by weight based on the heat-sensitive layer, and preferably from 60 to 90% by weight. The Examiner's attention is directed to column 3, line 60 to column 4, line 4 of the reference in this regard.

The examples of the reference confirm that titanium oxide is present in amounts of **at least 48%** by weight (Example 1: **53.4%**; Example 2: **48.3%**; Example 3: **55.7%**; Example 4: **54.5%**; and Example 5: **52.1%**). The particles are incorporated into the composition to "provide a uniform rough texture consisting of microscopic hills and valleys" (see paragraph bridging columns 3 and 4 of the reference). In order to achieve this result, the particles are present in significant amounts as discussed above.

*An image forming layer is thus taught by the reference which contains as an essential ingredient significant amounts of metal oxide particles.*

By contrast, applicants' claimed photosensitive composition does not contain metal oxide particles as an essential component

in the amounts contemplated by the reference. Claims 2, 3 and 37 were previously amended to state that the recited photosensitive composition "consists essentially of" the recited components (which precludes the presence of metal oxide particles in such large amounts).

The Examiner in the Advisory Action of February 17, 2005 takes the view that applicants' claim amendments do not distinguish over the cited reference, stating "Applicant has not demonstrated how other components of the image forming layer taught by Verschueren et al, particularly the metal oxide particles, materially affect the basic and novel characteristics of the claimed invention." The Examiner relies on *In re Herz*, 190 USPQ 461 (CCPA 1976) as support for this position.

Applicants again state that the Examiner's position is without basis. Applicants' claims are rejected as being anticipated by the reference. The reference clearly fails to suggest a composition which contains little, if any, metal oxide particles - the reference instead teaches that the composition should contain metal oxide particles in amounts of from 50-95% by weight. The reference thus clearly fails to disclose or anticipate applicants' claimed invention.

Indeed, it is noted that the *Herz* decision relied upon affirmed a rejection under 35 USC 103, not one under 35 USC 102. The *Herz* decision is accordingly believed inapplicable to the

present fact situation where the Examiner rejects the claims under 35 USC 102.

In further response to this rejection, applicants submit herewith a Declaration under 37 CFR 1.132 which confirms that the incorporation of metal oxide particles in the photosensitive composition of the present invention (in the amounts taught by the reference) materially changes the basic and novel characteristics of the claimed invention.

More specifically, the incorporation of 50% by weight  $\text{TiO}_2$  (calculated on a % solids basis) -  $\text{TiO}_2$  being an essential component of Verschueren - in both the photosensitive layer of Example 25 and the photosensitive layer of Example 1 yields inferior results in comparison to the working examples of the present invention with respect to printing performance. The Examiner's attention is directed to the attached Declaration in this regard.

Thus, applicants have demonstrated that the desirable effects of the claimed invention cannot be achieved by the incorporation of metal oxide particles in the photosensitive layer of applicants' invention in the amounts taught by the reference.

Applicants have further demonstrated that the presence of metal oxide particles in the photosensitive layer in the manner taught by the reference "materially affect the basic and novel

characteristics of the claimed invention".

The rejection is thus without basis and should be withdrawn.

**Rejection under 35 USC 102(e) over Leon et al and Van Damme**

Claims 2, 15, 18 and 29-30 stand rejected under 35 USC 102(e) as being anticipated by Leon et al. Claims 2, 15, 18, and 29-30 stand rejected under 35 USC 102(e) as being anticipated over Van Damme et al. These rejections respectfully are traversed.

While these rejections were previously withdrawn by the Examiner, the Examiner revives these rejections on the ground that "the claims do not specifically state that a hydrophobic polymer is present in the photosensitive layer as argued", with the Examiner further stating that "if Applicant were to amend the claims so that it is clear a hydrophobic polymer is in the photosensitive composition, the [102(e)] rejections would be withdrawn in addition to the rejection under 35 USC 112 (2<sup>nd</sup> paragraph)."

In response, claim 2 is amended to clarify that the hydrophobic polymer phase comprises a hydrophobic polymer.

By way of further distinction, Leon et al discloses an imaging member comprising a support having thereon a hydrophilic imaging layer comprising a hydrophilic heat-sensitive

crosslinked vinyl polymer that is thermally switchable with the polymer comprising repeating units comprising organoonium groups wherein post-imaging wet processing of the imaging member is not required (see claim 1).

Van Damme is directed to a heat-sensitive imaging element for providing a lithographic printing plate, comprising a support and as a top layer a heat switchable image-forming layer comprising a hardened hydrophilic binder and a heat swtichable polymer wherein the top layer or a layer adjacent to the top layer comprises a compound capable of converting light into heat (see claim 1).

The respective crosslinking agents of Leon and Van Damme are not polymers as asserted by the Examiner.

Leon and Van Damme are accordingly silent with respect to the presence of a hydrophobic polymer in the photosensitive composition as taught by the present invention.

As a result, and in view of the above amendment of claim 2, the Leon and Van Damme references cannot be deemed to anticipate the claimed invention, and the rejections thereover should be withdrawn.

In view of the above, the application is believed to be in condition for allowance and an early indication of same is earnestly solicited.

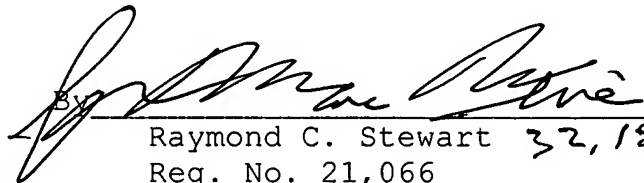


A check in the amount of \$1020.00 is attached for the requested three month extension of time.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

  
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Attachment: Declaration under 37 CFR 1.132 dated September 9,  
2005